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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/806,508 | 03/23/2004 | John T. Stites | 005127.00222 | 2719 |
| 22908 7590 01/09/2009 BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606 | | | | |
| EXAMINER | | | | |
| YOO, JASSON H | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3714 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/806,508

Applicant(s)

STITES ET AL.

Examiner

Jasson H. Yoo

Art Unit

3714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-13.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

/Peter DungBa Vo/
Supervisory Patent Examiner, Art Unit 3714

Continuation of 13. Other:

Claims 1-2, 5, 10-11 are rejected under 35 USC 103(a) as being unpatentable over Storek in view of Petrash. Applicant asserts that Storek nor Petrash either individually or in combination teach a first accelerometer module removably mounted in a head of the golf club. However, Storek teaches an accelerometer (10 in Figs. 1 and 4, along with paragraphs 39, 41-44, 49, -55, 69) within the head (14 in Fig. 4) of the golf club (11). Petrash discloses a method of attaching an accelerometer to a golf club. Petrash reference was relied upon to teach the method of having a removable accelerometer. Storek alone teaches that the location of the accelerometer mounted in a head of the golf club. Thus modifying Storek's reference of a golf club comprising an accelerometer module mounted in a head of the golf club with Petrash's method of having a removable accelerometer teaches the claim limitation of an accelerometer module removably mounted in a head of the golf club. It appears that Applicant's arguments are based on bodily incorporating the Petrash into the structure of Storek's. However, it is noted that the test of obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. Rather the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art. See MPEP 2145 section III and In re Keller, and also In re Sneed. In this case, Storek teaches the accelerometer in the head of the golf club and Petrash teaches that accelerometers are removable. Therefore Storek in view of Petrash discloses the claimed invention.

Applicant also argues that In re Dulberg is contrary to the MPEP and applicable case law since Petrash explicitly states that the accelerometer may be removable. However, a supporting rejection was made in view of Storek as supported by In re Dulberg; and not in view of Petrash. Storek discloses an accelerometer mounted in a head of the golf club. In re Dulberg supports that it is obvious to have components in an invention removable. Thus it would have been obvious to modify Storek accelerometer mounted in a head of the golf club, and modify the accelerometer to be removable, as supported by In re Dulberg.

Claim 6. Applicant asserts that Storek in view of Petrash in view of Evans as supported by Lagerblade fails to teach an antenna that comprises a ferrule. Again, it appears that Applicant tries to bodily incorporate the prior art references to disclose the claimed invention. However as discloses in MPEP 2145 and In re Keller, and also In re Sneed, the test of obviousness is not whether the features of a secondary reference may be bodily incorporated in the structure of the primary reference. Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art. In this case Evans discloses the golf club serves as a transmitting antenna (col. 2:17-19) and Lagerblade supports the teaching that a ferrule is part of a golf club that is used to connect the head of the golf club to the shaft of the golf club. See rejection for claim 6 in Office Action dated 9/9/08.